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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/477,405	01/04/2000	TATSUYA FUJIKI	1442.1007	9196

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STAAS & HALSEY LLP
700 11TH STREET, NW
SUITE 500
WASHINGTON, DC 20001

EXAMINER

LEA EDMONDS, LISA S

ART UNIT PAPER NUMBER

2835

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/477,405

Applicant(s)

FUJIKI ET AL.

Examiner

Lisa Lea-Edmonds

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. Figure 9 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "40" and "240" have both been used to designate portable PC on page 22. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "84" has been used to designate both multi-bay adapter and multi-bay; reference character "70" has been used to designate both expanding unit and music CD reproducer. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

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351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Yanagisawa et al. (5805412). With respect to claims 11-13, Yanagisawa et al. teaches a function expanding device (300) comprising a first connection (312a, 312b, 324, 325, 326) being connectable to a unit which expands a function of electronic hardware (100); a second connection part (321) being connectable to the electronic hardware; an operation part for the unit; and a display part (351) as claimed. With respect to claim 10, Yanagisawa et al. teaches a port replicator (200) having a third connection part (222) being connectable to the second connection part of the function expanding device; and a fourth connection part (221) being connectable to the electronic hardware (100) as claimed (see for example figures 1-15 and column 4 line 27 through column 16 line 4). With respect to the control part as claimed, the apparatus of Yanagisawa et al. is silent on the matters. However, the control part is inherent to a computer system comprising a drive unit having at least one control part such as a play, a on/off, a stop, an eject, and/or open/close key etc..

6. Claims 1-6, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Tanaka et al. (20020008497). The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. With respect to claims 1-9 and 8, Tanaka et al. teaches a function expanding device (60) comprising a first connection part (83) connectable to a unit (110, 130, 140, 150, 160, 170, 180) which expands a function of an electronic device (40); a second connection part (95) connectable to the electronic hardware (40); an operation part

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that enables a user to drive the unit (110, 130, 140, 150, 160, 170, 180) independent of driving the unit (110, 130, 140, 150, 160, 170, 180) by the electronic hardware (40); and a housing (70) forming the first and second connection parts; wherein the function expanding device (60) further comprises a control part which may control the unit (110, 130, 140, 150, 160, 170, 180) independent of the electronic hardware (40); wherein the operation part may power on at least part of the electronic hardware (40); wherein the second connection part (95) is connectable to a port replicator, and connectable to the electronic hardware (40) via the port replicator, wherein the second connection part (95) has a cable (see lines 1-3 on page 8); and wherein unit (110, 130, 140, 150, 160, 170, 180) is selected from a group of a music CD drive, a CD-ROM drive, A DVD-ROM drive, and a LS-120 drive, and the first connection part (83) has a bay structure compatibly to either drive in the group (see for example figures 2-26). With respect to claims 2-4, it is noted that applicant's use of the term "may" does not impart structural nor positive limitations on the work or phrase preceding it. The term "may" merely indicates a certain measure of likelihood or possibility.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al. as applied to the claims above, and further in view of Jacobs et al. (6073187). With respect to claims 7 and 9, Tanaka et al. teaches the invention as set forth by claim 1 above, however, Tanaka et al. lacks a clear teaching of the use of a display part which displays a status

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of the unit and the second connector part (95) having an IDE interface and a music interface as claimed. The apparatus of Jacobs et al. teaches a display part, which displays a status of the unit and a connector part having an IDE interface and a music interface as claimed (see for example figures 4-6 and column 3 line 3 through column 9 line 67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Jacobs et al. into the apparatus of Tanaka et al. to provide the user with means to view the status of the unit (110, 130, 140, 150, 160, 170, 180) and means to communicate therewith.

Response to Arguments

9. Applicant's arguments filed 03/10/03 have been fully considered but they are not persuasive. With respect to applicant's remarks concerning Yanagisawa et al., it is the position of the examiner of record that the above rejection using Yanagisawa et al. stands. It is understood that applicant argues the feature of the port replicator being "detachably" connectable to a function expanding device, which includes an operation part that enables the user to drive the unit independently of driving the electronic hardware. The examiner of record believes the apparatus of Yanagisawa et al. reads on the claimed invention in that Yanagisawa et al. teaches the port replicator being detachably connectable (see figures 5, 6, and 12), as well as a function expanding device as claimed. With respect to the control part, applicant is directed to any of Lee et al. (6134376), Jacobs et al. (6073187), or Ganthier et al. (6353533) for a clear teaching of a control part.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please note the teachings of Ganthier et al., Jacobs et al., Shih, Fuchida, Shen et al. and Morita.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Lea-Edmonds whose telephone number is 703-305-0265. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached on 703-308-4815. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3431 for regular communications and 703-305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1782.

Lisa Lea-Edmonds
Examiner
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A handwritten signature in black ink, appearing to read 'Lisa Lea-Edmonds', with a stylized flourish at the end.

May 2, 2003